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OFFICE OF PETITIONS

In re Patent No. 7,575,893	:	
Simmons	:	DECISION ON REQUEST FOR
Issue Date: August 18, 2009	:	RECONSIDERATION OF
Application No. 10/764,428	:	PATENT TERM ADJUSTMENT
Filed: January 23, 2004	:	AND NOTICE OF INTENT
Attorney Docket No.	:	TO ISSUE CERTIFICATE OF
146392004900	:	CORRECTION
Title: METHODS FOR PRODUCING	:	
HUMANIZED ANTIBODIES AND	:	
IMPROVING YIELD OF ANTIBODIES	:	
OR ANTIGEN BINDING FRAGMENTS IN	:	
CELL CULTURE	:	

This is a decision on the petition filed on October 16, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one hundred ninety-four (194) days. This requested correction includes, pursuant to their duty of candor and good faith to the Office, additional periods of reduction of 77 and 21 days

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED TO THE EXTENT INDICATED HEREIN.**

Patentee's calculations include 295 days under 37 CFR 1.702(a) plus 142 days under 37 CFR 1.702(b) minus 243 days under 37 CFR 1.704 for applicant delay. The net result of patentee's calculation yields 194 days.

The petition will first address patentees candor comment. Pursuant to their duty of candor and good faith to the Office, patentees disclose that the Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) patentee has informed the

Office that there are two additional instances in which a reduction is required.

Patentee is correct that a reduction of 77 days should have been entered based on 37 CFR 1.704(c)(8). 37 CFR 1.704(c) provides that:

Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed;

It is undisputed that patentees submitted an IDS on August 31, 2007, after filing an initial response on June 15, 2007, to the final Office action. The record does not support a conclusion that the examiner expressly requested the IDS. Thus, patentees failed to engage in reasonable efforts to conclude prosecution of the application.

Patentees are also correct that a reduction of 21 days based upon 37 CFR 1.704 (c)(10). 37 CFR 1.704(c) provides that:

Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(10) Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;

or

(ii) Four months;

An IDS was submitted on June 17, 2009, after the mailing of the Notice of Allowance on April 8, 2009. A notice acknowledging the submission of the IDS was mailed on July 7, 2009. This period is 21 days, counting the number of days in the period beginning on June 17, 2007 and ending on July 7, 2007. Thus, patentee failed to engage in reasonable efforts to conclude prosecution of the application.

As such patentees delay totals 243 days (60 + 30+ 77+ 26+ 29 + 21).

The patent is entitled under 37 CFR 1.702(a) to 295 days. The period of adjustment to which the patent is entitled under 37 CFR 1.702(b) is 142 days. There are zero days of overlap between 37 CFR 1.702(a) and 37 CFR 1.702(b).

Patentee's calculation does not reflect the reduction of 59 days in connection with the Notice of Appeal filed April 17, 2007. The reduction commenced April 17, 2007, the date that the Notice of Appeal was filed, and ended June 14, 2007, the day before the filing of the request for continued examination (RCE) was filed. See, 37 CFR 1.703(b)(4).

In view thereof, the patent is entitled to an overall adjustment of 135 days (295 days under 37 CFR 1.702(a) + 142 days under 37 CFR 1.702(b) - 0 overlapping days - 59 days pursuant to 37 CFR 1.703(b)(4) = 243 days of applicant delay).

The application is being forwarded to the Certificate of Corrections Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one hundred thirty-five (135) days**.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to Petitions Attorney, Charlema Grant at (571) 272-3215.

/ALESIA M. BROWN/

Alesia M. Brown
Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,575,893 B2

DATED : August 18, 2009

DRAFT

INVENTOR(S) : Simmons

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 150 days

Delete the phrase "by 150 days" and insert – by 135 days--